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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,261	01/19/2004	William Freeman	15436.121.1.1	6915

22913 7590 05/17/2006

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EXAMINER

BLACKWELL RUDASIL, GWENDOLYN A

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,261

Applicant(s)

FREEMAN ET AL.

Examiner

Gwendolyn Blackwell

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to an electrochromic window, classified in class 428, subclass 432.
 - II. Claims 16-24, drawn to a method of making an electrochromic window, classified in class 427, subclass 248.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make a materially different product. The product requires first and second plates, first and second conductive electrodes, and an attenuation layer. The process only requires one conductive layer, an electrolyte material, and an electrochromic layer. As it stands, the process would not make the product.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with R. Burns Israelsen on April 25, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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16-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-10, 12, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 5,668,663, Varaprasad et al.

Regarding claims 1 and 8

Varaprasad et al disclose an electrochromic device, such as a window (column 1, lines 6-11) comprised of first and second substrates positioned in a spaced apart relationship being substantially parallel. First and second conductive electrodes are positioned on the inner surfaces (the surfaces that face each other) of the first and second substrates, (columns 13-14, lines 45-41). Between the conductive electrodes, an electrochromic material layer and an electrolyte material layer (the combined electrochromic layer/electrolyte layer form Applicant's attenuation

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layer) are formed, (column 7, lines 53-64). The electrolyte material is comprised of redox reaction promoters and alkali ions and/or protons wherein one of the alkali ions may be lithium methacrylate (photopolymerizable element), (columns 8-10, lines 56-58), meeting the limitations of claims 1 and 8.

Regarding claims 2-3, 5-7, 9-10, 12, and 14-15

The substrates can be formed of glass, (column 13, lines 26-41), meeting the limitations of claims 2 and 9.

The electrodes and glass substrates are transparent and transmissive in part in the visible portion of the electromagnetic spectrum, (column 15, lines 6-65), meeting the limitations of claims 3 and 10.

As light passes through the electrolyte layer, a portion of the electromagnetic spectrum is absorbed (attenuated), (columns 11-12, lines 61-8), meeting the limitations of claim 5.

Between the conductive electrodes, an electrochromic material layer and an electrolyte material layer (the combined electrochromic layer/electrolyte layer form Applicant's attenuation layer) are formed, (column 7, lines 53-64), meeting the limitations of claim 6.

The electrochromic/electrolyte layers are activated by an applied potential between the conductive electrode coatings by any source of an alternating current or a direct current (voltage), (column 23, lines 39-49), meeting the limitations of claim 7.

The electrolyte material is comprised of redox reaction promoters and alkali ions and/or protons wherein one of the alkali ions may be lithium methacrylate (photopolymerizable element) which form either a liquid or solid solution, (columns 8-10, lines 56-58), meeting the limitations of claims 12 and 14-15.

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8. Claims 1-4 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 6,193,378, Tonar et al.

Regarding claims 1, 4, 8, and 11-13

Tonar et al disclose an electrochromic device that can be a window, (column 11, lines 47-50 and column 12, lines 53-57). The device is comprised of first and second substrates with a first electrode on the inner surface of the first substrate and a second electrode on the inner surface of the second substrates wherein the two substrates are in a spaced apart relationship with an electrochromic element formed between the two electrodes, (column 3, lines 38-67). The electrochromic element is comprised of an electrolyte and an electrochromic medium, (column 4, lines 46-67). The example demonstrates that the electrochromic solution also contains polymethylmethacrylate (photopolymerizable monomer), (column 10, lines 32-37), meeting the limitations of claims 1, 4, 8, and 11-13.

Regarding claims 2-3, 7, and 9-10

The substrates are made of glass, (column 10, lines 17-24), meeting the limitations of claims 2 and 9.

The conductive electrodes are transparent, which would allow for the transmission of at least a portion of visible light, (column 3, lines 57-65), meeting the limitations of claims 3 and 10.

The reflectivity of electrochromic element is activated through the use of an applied voltage, (column 3, lines 37-41), meeting the limitations of claim 7.

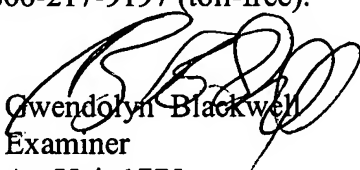
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Blackwell whose telephone number is (571) 272-1533. The examiner can normally be reached on Monday - Thursday; 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gwendolyn Blackwell
Examiner
Art Unit 1775

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